

REMARKS

In the Office Action mailed September 12, 2005, claims 1-15 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Publication No. 2004/0267902 in the name of Yang in view of U.S. Patent No. 6,623,529 to Lakritz. All claims were also provisionally rejected under judicially established doctrine of obviousness-type double-patenting over claims 1-10 of copending U.S. Application No. 10/452,838.

Applicant submits a Terminal Disclaimer herewith as part of the response to the Office Action. U.S. Application No. 10/452,838 has been allowed and is expected to issue. The Terminal Disclaimer therefore overcomes the expected non-provisional rejection under judicially established doctrine of obviousness-type double-patenting.

MPEP § 2143 establishes the following standard for a finding of a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As is detailed below, neither the Yang and Lakritz references nor the knowledge of persons of ordinary skill in the art provide any motivation to combine the respective teachings the Yang and Lakritz references. Furthermore, the combination of the Yang and Lakritz references do not teach or suggest all the limitations of the claims. In view of these shortcomings, the combination of the Yang and Lakritz references do not establish a *prima facie* case of obviousness over the rejected claims.

The Yang reference discloses a SCSI-to-IP cache storage system. This system is intended to facilitate the creation of a storage area network (SAN) implemented over

the Internet. Thus, computers located in different geographical locations, each being connected to the Internet through a SCSI-to-IP device, are able to access data stored on other similarly connected SCSI-to-IP devices. Thus, the SCSI-to-IP cache storage system disclosed by Yang necessarily relies on each computer within the network being locally connected to a SCSI-to-IP device. Such a configuration allows all computers within the network to read and write to any file stored on any SCSI-to-IP device within the network. See Yang, ¶¶ 36-41. In addition, a file may be stored on any single SCSI-to-IP device, or it may be fragmented and stored across several SCSI-to-IP devices.

Having each SCSI-to-IP device localized to individual computers is an important aspect of the cache storage system disclosed by the Yang reference. As stated in the Yang reference, "The SCSI-to-IP cache storage system allows direct connection to a SCSI interface of a computer that in turn can access a SAN implemented over the Internet." Yang, ¶ 12. In fact, having the SCSI-to-IP devices connected directly and locally to each respective computer is an inherent limitation in the SCSI interface, which is limited to short distance connections of generally less than 6 feet.

In contrast to the Yang reference, the Lakritz reference discloses a visitor (translation) module 202 for use in translating web pages into different languages for visitors to those web pages. While the Lakritz reference does not expressly disclose the location of the visitor module, it does imply that the visitor module is localized to the server 203 hosting the web pages being translated. See, *generally*, column 1, line 39 – column 2, line 67. By localizing the visitor module 202 with the web server 203, the web content is translated only once into a particular language and provided to the various visitors of the web site who require a particular translation. In this manner, the Lakritz reference discloses that a single visitor module is able to provide consistent translations to all web page visitors. Further, the Lakritz reference discloses that having the translation module integrated into the end user's web browser, i.e., localized to the computer accessing the web server, is an undesirable feature because "errors occur in

the translation and the appropriate content is not consistently displayed to the user.” (Column 1, lines 25-32.) For these reasons, the Lakritz reference discloses that the visitor module is localized to the web server, instead of being localized to the computer accessing the web pages.

Thus, neither the Yang reference nor the Lakritz reference provide any motivation to combine the respective technologies. Where the Yang reference teaches that the SCSI-to-IP devices are locally attached to computers, the Lakritz reference teaches that the visitor module is remote from visitors’ computers and localized to the web server. Where the Yang reference teaches that the local computer has read and write access to data stored on the SAN, the Lakritz reference teaches that visitors’ computers have read only access to web pages hosted on the server. These differences between the Yang and Lakritz references are clear indicators that one skilled in the art would have no motivation to combine the respective teachings.

Even if the teachings of the Yang and Lakritz references provide the proper motivation for combination, such a combination does not teach all limitations of the rejected claims. Claim 1 includes the limitations of the processor being “adapted to employ the network interface for communications exclusively with the remote file server” and the processor returning “a file unavailable notice to the computer if the file is not cached on the storage means and not obtainable from the file server.” Neither the Yang reference nor the Lakritz reference expressly or inherently disclose either of these limitations.

As discussed above, the Yang reference teaches a SCSI-to-IP device which enables creation of a SAN over the Internet in combination with other SCSI-to-IP devices. Importantly, each SCSI-to-IP device within the SAN is enabled for network communications with each and every other SCSI-to-IP device on the network and with a network-attached storage (NAS). Thus, no single SCSI-to-IP device “exclusively” communicates with any other SCSI-to-IP device or with the NAS. Furthermore, the

Yang reference is silent as to how an individual SCSI-to-IP device handles file requests when the requested file is unavailable, either locally or from other devices within the SAN. The Yang reference thus does not teach all of the limitations of claim 1.

The Lakritz reference fails to teach the limitations of claim 1 which are not taught by the Yan reference. For one, the Lakritz reference is completely silent as to how many web servers a single visitor module may communicate with. Because the Lakritz reference is silent as to this functionality of the visitor module, it does not teach the limitation of claim 1 that “the processor is adapted to employ the network interface for communications exclusively with the remote file server”. The Lakritz reference also expressly states that one purpose of the visitor module is to ensure that the “visitor will never see an error message (i.e., a ‘404-document not found’) because the requested content is not available in the visitor’s language.” (Column 6, lines 31-34.) In view of this express statement, the Lakritz reference does not teach the limitation of claim 1 that the processor returns “a file unavailable notice to the computer if the file is not cached on the storage means and not obtainable from the file server.”

For the above-stated reasons, the combination of the Yang and Lakritz references does not establish a *prima facie* case of obviousness over claim 1. Further, where this combination does not render claim 1 obvious, it also does not establish a *prima facie* case of obviousness over claims 2 and 3, each of which depends from claim 1.

The combination of the Yang and Lakritz references also does not disclose all the limitations of claim 4, which includes the limitations of “the processor is adapted to employ the network interface for communications exclusively with the remote file server” and the processor returning “a file unavailable notice to the computer if the file is not cached on the storage means and not obtainable from the file server”. As stated above, the cited combination does not disclose either of these limitations and therefore does not establish a *prima facie* case of obviousness over claim 4. Further, where the cited

combination does not render claim 4 obvious, it also does not establish a *prima facie* case of obviousness over claims 5 and 6, each of which depends from claim 4.

The combination of the Yang and Lakritz references also does not disclose all the limitations of claim 7, which includes the limitation of the storage device being “the computer interface being adapted to enable communications exclusively between the computer and the storage device”. Again, the cited combination does not disclose this limitation and therefore does not establish a *prima facie* case of obviousness over claim 7. Further, where the cited combination does not render claim 7 obvious, it also does not establish a *prima facie* case of obviousness over claims 8 and 9, each of which depends from claim 7.

Claim 10 includes the limitation of “receiving at the storage device notice from the file server that an updated version of the first file exists on the file server, whereupon the cached copy of the first file is deleted.” The process of deleting a cached file upon receiving notice that an updated version is available from a server is not disclosed in either the Yang reference or the Lakritz reference. As such, the combination of the Yang and Lakritz references is insufficient to establish a *prima facie* case of obviousness over claim 10.

The combination of the Yang and Lakritz references also does not disclose all the limitations of amended claim 11, which includes the limitations of “the processor is adapted to employ the network interface for communications exclusively with the remote file server” and the processor returning “a file unavailable notice to the computer if the file is not cached on the storage means and not obtainable from the file server”. As stated above, the cited combination does not disclose either of these limitations and therefore does not establish a *prima facie* case of obviousness over amended claim 11. Further, where the cited combination does not render amended claim 11 obvious, it also does not establish a *prima facie* case of obviousness over claims 12 and 13, each of which depends from amended claim 11.

The combination of the Yang and Lakritz references also does not disclose all the limitations of amended claim 14, which includes the limitations of "the processor is adapted to employ the network interface for communications exclusively with the remote file server" and the processor returning "a file unavailable notice to the computer if the file is not cached on the storage means and not obtainable from the file server". As stated above, the cited combination does not disclose either of these limitations and therefore does not establish a *prima facie* case of obviousness over amended claim 14. Further, where the cited combination does not render amended claim 14 obvious, it also does not establish a *prima facie* case of obviousness over claim 15, which depends from amended claim 14.

For the reasons stated above, Applicant hereby requests reconsideration of the rejected claims.

Respectfully submitted,

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